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Serial no. 09/921,841
Filed 8/2/2001
Attorney docket no BEA920010012US1

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REMARKS

Claim rejections under 35 USC 112

Claim 19 has been rejected under 35 USC 112, second paragraph, as being indefinite. In particular, the Examiner has rejected the portion of this claim relating to a modulated carrier signal. Applicant has amended claim 19 to remove this portion of the claim, and submits that claim 19 is now definite under 35 USC 112, second paragraph.

Claim rejections under 35 USC 103(a)

Claims 1-20 have been rejected under 35 USC 103(a) as being unpatentable over EFI Application Toolkit Protocol Specification (hereinafter, "EFI"), in view of Goodman (2002/0091807), and further in view of Noel (2002/0010844). Applicant respectfully traverses the rejection as to the claims, as amended, as is now discussed.

In the previous office action response, Applicant amended the independent claims such the rebooting of the one or more nodes is not explicitly performed. Applicant argued that EFI in view of Goodman specifically require the rebooting of nodes, such that the claimed invention was not rendered obvious by the prior art. In the final office action, the Examiner found non-rebooting in an additional reference, Noel, and combined EFI and Goodman with Noel to yield the claimed invention as amended. However, Applicant submits and strongly contends that the combination of EFI in view of Goodman with Noel is improper. Applicant provides two separate reasons in this regard.

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Goodman not considered in its entirety and Goodman teaches away from claimed invention

First, black letter law states that a "prior art reference must be considered in its entirety, i.e., as a whole, *including portions that would lead away from the claimed invention.*" (MPEP 2141.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir. 1983)) Reading Goodman in its entirety leads one of ordinary skill within the art to conclude that rebooting is necessary. For instance, in paragraph [0027], Goodman states that "the updated nodes reset themselves and the new firmware image is activated," and in paragraph [0029], "the remaining nodes are then reset through a remote reset or reboot message." The Examiner cannot utilize one part of Goodman without considering the entirety of Goodman. That is, even if another reference, such as Noel, teaches non-rebooting of the nodes, that does not mean that the teachings of Goodman as a whole can be ignored, since Goodman must be considered in its entirety. And Goodman quite simply requires rebooting, in contradistinction to the invention.

The Federal Circuit has informed that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (In re Fritch, 972 F.2d 1260 (Fed Cir. 1992)) However, this is what is going on here. The Examiner is taking a little bit of Goodman, ignoring other explicit teachings of Goodman, and then taking a little bit of Noel, to combine with EFI to yield the claimed invention. That is, EFI in view of Goodman teaches the claimed invention, but *with* rebooting of the nodes, and Noel cannot be additionally added to the point of ignoring the teachings of Goodman as a whole.

The issue, in other words, is not that EFI in view of Goodman teaches the claimed invention, but is silent as to the non-rebooting of nodes limitation, such that Noel can then be relied upon for this aspect of the claimed invention. Rather the issue is that EFI in view of Goodman, *in their entirety*, teaches the claimed invention, but *requires* the rebooting of the nodes. So it is not a simple matter of finding another references that teaches non-rebooting of the nodes, as Noel does, because Goodman requires rebooting of the nodes, and Goodman must be

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considered in its entirety. Noel is thus not properly combined with EFI and Goodman to yield the claimed invention.

Applicant provides one more way of looking at this issue, with a very diagrammatical approach, using claim 1 as representative of the independent claims of the claimed invention. Claim 1 has three steps and a wherein clause. Say the three steps are labeled elements A, B, and C of the invention, and the wherein clause is called element D of the claimed invention. Now, EFI in view of Goodman seemingly teach elements A, B, and C. If EFI in view of Goodman was silent as to element D, then the Examiner would be correct in further adding Noel into the mix as adding element D to yield the claimed invention. However, what is going on here is that EFI in view of Goodman is *not* silent as to element D; rather Goodman in its entirety specifically says that element D cannot be done. Therefore, adding Noel with its element D is improper, because it ignores Goodman's teaching as a whole that element D is not to be accomplished. Considering Goodman as a whole thus means that Noel is not properly combined with Goodman in view of EFI – Goodman explicitly teaches away from combining Noel with Goodman and EFI in the way the Examiner wants to do.

Combining Noel with EFI and Goodman changes the principle of operation of Goodman

Second, black letter law also states that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings are not sufficient to render the claims *prima facie* obvious.” (MPEP 2143.01, citing *In re Ratti*, 123 USPQ 349 (CCPA 1959)) The Ratti decision is very informative in this regard. In Ratti, the claimed invention required resiliency to operate, whereas one of the prior art references relied upon required rigidity to operate. The CCPA held that the suggested combination of references “would require a substantial reconstruction and redesign of the elements shown” in the prior art reference requiring rigidity to operate, and furthermore would

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require "a change in the basic principle under which" this reference "was designed to operate." (MPEP 2143.01)

The teachings of Ratti and MPEP 2143.01 are particularly apt as to the present situation. Combining EFI and Goodman results in nodes being rebooted in performing the claimed invention. For instance, in paragraph [0027], Goodman states that "the updated nodes reset themselves and the new firmware image is activated," and in paragraph [0029], "the remaining nodes are then reset through a remote reset or reboot message." Similar to the prior art reference in Ratti requiring rigidity to operate, Goodman requires rebooting to operate, whereas the claimed invention requires no rebooting. The principle of operation of Goodman is thus that rebooting is necessary to reset the nodes, and combining Noel, which teaches no rebooting, with EFI in view of Goodman, changes this principle of operation of Goodman.

Furthermore, modifying EFI in view of Goodman with the teachings of Noel, which does not require rebooting, "would require a substantial reconstruction and redesign" of Goodman, which is also not allowed in Ratti and by the MPEP. Goodman is operative by having its node being reset through rebooting. It is not a simple matter of combining Noel with EFI and Goodman to "save[] time and increase[] operating speed," per the motivation indicated in the final office action to combine EFI, Goodman, and Noel, because doing so would destroy the principle of operation of Goodman. In sum, Goodman requires rebooting, such that Noel is not properly combined with EFI and Goodman, where such a combination would require a substantial reconstruction and redesign of Goodman.

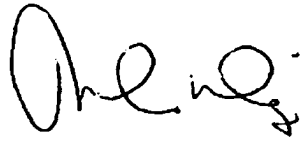
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Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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